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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,078	06/22/2000	H. Brock Kolls	USE-5434US2	8864

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,078

Applicant(s)

KOLLS, H. BROCK

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 51-54 are pending and are examined.

Claim Objections

2. Claims 51-54 are objected to because of the following informalities:

Claims 51-54 use terms "phone card" and "smart card" interchangeably.

Since there is no specific limitation included in claims that render functionality of a phone card distinct from a smart card, the examiner has interpreted the claims to read "smart card" in place of "phone card".

Claim 52 line 1 reads "the value a phone card", should read "the value of a phone card".

Claim 54 line 4 "and or" should be changed to "and/or".

Appropriate correction(s) is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 52-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 52 preamble recites "A phone card revaluing method for altering the value of a phone card by way of an electronic commerce terminal system..".

However, there is no limitation(s) that recite step(s) that perform revaluing or altering the value of a phone card (or a smart card because "phone card" and "smart card" have been used interchangeably).

Dependent claims inherit same deficiency as claim 52.

Claim 54 recites "communicating said transaction data to a universal server can include dynamic identification interchange step...". The usage of term "can include" renders the claim vague and indefinite because the claim does not further limit the process of its parent claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 52-54 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Molano et al. (US Pat. 6,330,978).

As per claim 52, Molano teaches a phone card revaluing method for altering the value of a phone card by way of an electronic commerce terminal system (abstract) comprising steps of:

- a) detecting a phone card has been inserted or swiped in a card reader (col. 24-34, "card reader 22 is capable of reading both smart cards and magnetic strip cards, col. 8 12-13, "inserting ..card into the card reader");
- b) retrieving a plurality of transaction data from said smart card (col. 8 L 13-23, refer to "valid account data" and valid account number);
- c) communicating said transaction data to a universal server (col. 9 L 38-44, terminal 12 transmits "request message" to the host");
- d) evaluating the validity of said transaction data (col. 9 L 55-59, "response message" indicates whether or not the transaction is permitted); and
- e) processing said transaction data (col. 9 L 64- col. 10 L 8, refer to step 8.0 as discussed).

Claim 53: after the step of communicating said transaction data to a universal server, the user is prompted to enter a desired revalue (refer to col. 9 L 6-10, the prompt indicated the current value on the smart card to which additional value is to be loaded).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molano et al. as applied to claim 52 above, and further in view of Renner et al. (US Pat. 6,223,984) (hereafter Renner).

Molano fails to explicitly teach the step of communicating said transaction data to a universal server as recited in claim 54. In the same field of endeavor, however, Renner teaches a method of communicating transaction data from a smart card to a universal server which includes a dynamic identification interchange step to convert said transaction data by way of a convert data step (Renner, col. 5 L 37-42 and col 7 L 25 – 32, “this code is converted into a stream of data bits... compatible with a magnetic stripe reader) (note that the examiner has interpreted the term “dynamic identification interchange (DII)” as per disclosure, see p. 29 L 5-10 and Figure 11 transaction routine 900 block 908, Accordingly DII is interpreted as a process of performing one of the recited functions).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a dynamic identification interchange step to convert the transaction data by way of a convert data step. Because doing so would facilitate communication of the transaction data between the smart card reader and the universal server by making the communicated data compatible with both devices (in this instance, the card reader and the universal server).

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pieterse et al. (US Pat. 5,714,741) teach a device for providing a transparent exchange of commands and data between an IC card and a remote terminal via a communication network.

Feiken (US-PAT-NO: 6070795) teaches a method of making recoverable smart card transactions, a method of recovering such a transaction, as well as a smart card allowing recoverable transactions.

Dorf (US-PAT-NO: 6189787) teaches a multifunction card system which provides a multifunction card capable of serving as a prepaid phone card, a debit card, a loyalty card, and a medical information card.

Lee-Wai-Yin (US-PAT-NO: 6167387) teaches a cashless card revalue system.

Davis et al. (US Pat. 6,282,522) teach an Internet payment system using smart card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240. **Draft faxes may also be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Jagdish N. Patel

(Examiner, AU 2164)

February 28, 2002